

REMARKS

Claims 18-20 are pending in this application. Claims 18, 19 and 20 are amended to include a pH adjuster that adjusts pH to within a range of 5-6. Support is found, for example, at Tables 2 and 3 and in paragraph [0040] of the specification. Claim 19 was further amended to recite an amount of the reaction film-forming agent of 0.1 to 5 wt % based on the total amount of the grease composition, and claim 20 was amended to recite an amount of the inorganic compound of 0.005 to 3 wt % based on the total amount of the grease composition. Support is found, for example, at paragraph [110] and at paragraph [125].

Review and reconsideration on the merits are requested.

Claim 18 stands rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Office Action alleges that there is no support in the specification for the lower limit of the pH adjustor of 0.01 wt % as recited in claim 18.

The recitation, “the amount of the pH adjustor is 0.01” in instant claim 18 finds support in the specification at, for example, page 62, Table 3, Examples 22 and 26.

Thus, this rejection is improper, and withdrawal of the rejection is respectfully requested.

Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokouchi et al (JP 9-169989) in view of Heimann et al (U.S. Patent 6,010,984). The Office Action alleges that Yokouchi et al discloses each claimed feature, except for the addition of a pH adjustor, which is allegedly disclosed in the form of amine compounds. Heimann et al is cited for disclosing a lubricant and grease composition having a variable pH, e.g., a pH of from about 7 to about 14. Thus, in view of Heimann et al, it would allegedly have been obvious to have

added a pH adjustor to the grease composition of Yokouchi et al in order to adjust the pH and tailor the grease for compatibility with specific metal surfaces to improve corrosion resistance.

Applicants traverse the rejection and amend claims 18, 19 and 20 to include a pH adjuster that adjusts pH to within a range of “5-6.” This is a preferred range of the present invention, as shown, for example, by reference to bearing nos. 21-26 of Table 3 at page 62 of the specification. See also bearing nos. 11-17 in Table 2 at page 57 of the specification.

In contrast, as asserted by the Examiner, Heimann et al’s pH is adjusted to within the range of from about 7-14. Moreover, Yokouchi et al is silent with respect to the pH of the grease, and Yokouchi et al’s grease containing the additive in an amount of from 0.5 to 10% is disclosed as being sealed in the rolling bearing. Thus, no combination of Yokouchi et al and Heimann et al would have rendered obvious the features of instant claims 18-20.

Withdrawal of the foregoing rejection is respectfully requested.

Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Naka et al (U.S. Patent 5,728,659) in view of Heimann et al and Yokouchi et al. The Office Action relies on Heimann et al and Yokouchi et al as applied above, and further asserts that it would have been obvious to have added pH adjustors as taught by Heimann et al to the grease composition of Naka et al in order to adjust pH to from about 7 to about 14. It would also allegedly have been obvious to have added an inorganic filler as taught by Yokouchi et al in order to reinforce the gel structure and film-forming properties of the grease composition.

Applicants traverse the rejection for the same reasons as set forth above with respect to the rejection of Yokouchi et al in view of Heimann et al. In particular, the combination of Heimann et al and Yokouchi et al in no manner leads one skilled in the art to employ a pH adjustor in the grease composition of a rolling bearing, let alone a pH adjuster for adjusting the

pH to from 5-6. Further, Naka et al nowhere remedies the deficiencies of either Yokouchi et al or Heimann et al in this regard. Naka et al is silent regarding pH, and Naka et al's diurea compound is used as a thickening agent.

For at least the foregoing reasons, claims 18-20 would not have been obvious over any combination of Yokouchi et al, Heimann et al and Naka et al.

Withdrawal of the foregoing rejection is respectfully requested.

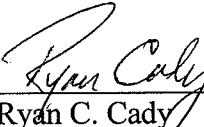
Withdrawal of all rejections and allowance of Claims 18-20 are earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington D.C. telephone number indicated below.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The U.S. Patent and Trademark Office is hereby directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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